

REMARKS UNDER 37 C.F.R. § 1.111

Appln. No.: 10/785,225

REMARKS

Claims 1-20 are pending in this application.

The Examiner rejects:

- claims 15, 16, 18 and 20 under 35 U.S.C. 102(e) as being anticipated by Back et al. (Back);
- claims 1-4, 6-12 and 14 under 35 U.S.C. 103(a) as being unpatentable over Back in view of Jain et al. (Jain);
- claims 5 and 13 under 35 U.S.C. 103(a) as being unpatentable over Back and Jain in view of Kotzin et al. (Kotzin); and
- claims 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Back in view of Kotzin.

Applicant respectfully traverses these rejections as follows.

Applicant's independent claim 8 provides a system for handing over a terminal from a first base station to a second base station, the system comprising a unique combination of features, including, *inter alia*, providing a roaming gateway and using an inter-system paging procedure without having to establish other systems separately (*see* Applicant's claim 8). On the other hand, Applicant's independent claims 1, comprising unique combinations of method steps, including, *inter alia*, performing notification via a roaming gateway and inter-system paging without having to establish other systems separately (*see* Applicant's claim 1).

Claims 15 and 18 provide methods, for handing over a terminal from a first base station to a second base station, each method comprising unique combinations of method steps, including, *inter alia*, providing notification about the fact that the terminal is ready to communicate in a second communication mode (*see* Applicant's claims 15 and 18).

Contrary to the Examiner's analysis, Back (the Examiner's primary reference) does not disclose, teach, or even remotely suggest such unique combinations of features or method steps .

Back discloses a conventional communication system and method where, as shown in FIG. 2 thereof, the communication system includes elements of UMTS and GSM networks and

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comprises a core network (CN) part 2, a UMTS terrestrial radio access network (UTRAN) part 8, 18, a GSM radio access network part 9 and two core network control entities which are two Mobile Services Switching Centers (MSC-A, MSC-B) 3,4 (*see Id.*, paragraphs [0049]-[0053]). In particular, Back discloses “an intersystem handover (UMTS to GSM) procedure wherein the channel configuration is changed in the communication system of FIG. 2” and “an interface that enables a change in the channel configuration by allocating a new channel after a UMTS to GSM handover”, where:

[0089] ... [T]he source radio network controller 6 sends a relocation required message (1.) to the relay network control entity 4. The relay control entity 4 sends a handover request message (2.) to the target base station controller 11. The handover request message contains information regarding the channel type that should be used for the session.

[0090] In response to the request (2.), the base station controller 11 reserves required radio resources. The reservation of the radio channel is performed within the limitations set by said information of the channel type in the message (2.) from the relay control entity.

[0091] After the reservation of resources the base station controller 11 acknowledges (3.) the request for the handover. The acknowledgement message (3.) includes information regarding the chosen channel the base station controller selected for the session.

[0092] In response to the acknowledgement message (3.) the relay control entity 4 sends relocation command message (4.) to the source radio network controller 6 [see FIG. 5, which is network controller (RNC) 7 in FIG. 2]. The radio network controller 6 may then signal an inter-system handover command (5.) to the user equipment 1.

[0093] The user equipment 1 is now enabled to access the new radio resources. The target base station controller 11 detects that the user equipment has accessed the new radio channel and sends a handover detect message (6.) to the relay control entity 4.

[0094] User equipment 1 may acknowledge (7.) to the base station controller 11 that the handover has been successfully completed. In response to this message the base station controller 11 may acknowledge (8.) the completion of the handover proceedings to the relay control entity 4.

[0095] Finally the relay control entity 4 confirms (9.) to the anchor control entity 3 that the handover has been performed. After this the Iu interface resources reserved by the handover proceedings can be released.

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(*See Id.*, paragraphs [0088] – [0095].)

That is, Back provides an interface which enables changing configuration by allocating a new channel after a handover procedure, UMTS to GSM. In order to provide the interface, which enables changing, parameters required in each communication method require careful consideration. Also, the change of interface results in inefficient use of resource.

Thus, in contradistinction to Applicant's claims 15 and 18, which require initialization operation to be performed between UA and a second base station (such as a Target BS), Back discloses that the operation of accessing a new radio (process subsequent to step 5, as illustrated in Fig. 5 thereof, which is an initialization operation) is performed between UE 1 and Relay MSC 4 (*see Id.*, Fig. 5). Furthermore, unlike Applicant's claims 15 and 18, which require notifying a first BSC (such as a Source BSC) that a terminal is ready to communicate in a second communication mode and UE to notify the source BSC regarding a terminal's readiness, Back discloses that its UE 1 sends a "Handover Complete" message 7 to Target BSC 11 after accessing the new radio (*see Id.*, Fig. 5).

Accordingly, Applicant's independent claims 15 and 18, as well as the dependent claims 16 and 20 (which incorporate all the novel and unobvious features of their respective base claims 15 and 18), are not anticipated by (i.e., are not readable on) Back at least for these reasons.

Also, with regard to Application's independent claims 1 and 8, Back does not disclose, teach or suggest controlling its user equipment 1 by providing a roaming gateway and using the inter-system paging procedure without establishing other systems separately. The Examiner's secondary references, Jain and Kotzin do not supply the above-noted teachings lacking in Back. For example, while Jain discloses a roaming gateway interface between a CDMA MSC and a GSM core infrastructure, so that a GSM-enabled CDMA mobile station having a subscription in the GSM system can perform communication, Jain does not disclose, teach or suggest paging a terminal by a second base station, notifying the terminal being ready to hand over upon recognizing that the second base station controller has completed the paging of the terminal, and

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does not disclose, teach or suggest a procedure for call set up between the second base station and the terminal.

Therefore, Applicant's independent claims 1 and 8, as well as the dependent claims 4-6 and 12-14, would not have been obvious from any reasonable combination of Back, Jain and Kotzin, at least for the reasons set forth above. Likewise, dependent claims 17 and 19, which incorporate all the novel and unobvious features of their respective base claims 15 and 18, would not have been obvious from any reasonable combination of Back and Kotzin at least for the reasons set forth above with regard to claims 15 and 18.

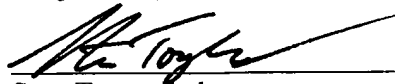
In view of the above, reconsideration and allowance of this application with claim 1-20 are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 18-2220. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,



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